

III. Remarks

Claims 1-11 are pending in this case. Of these, claims 1-7 stand rejected under 35 U.S.C. Section 112, first paragraph, for failure to comply with the written description requirement; claim 4 is objected to because “support elements” lacks antecedent basis; claims 6 and 7 are rejected under 35 U.S.C. Section 102(b) in view of Husted, U.S. Pat. No. 4,067,346; claim 1 is rejected under Section 103(a) as being obvious over Rush, U.S. Pat. No. 4,323,605, and alleged “prior art admissions”; claims 2, 3 and 5 are rejected, also under Section 103(a), for the reasons given in respect of claim 1, and further in view of the Husted reference; and claims 9-11 are new. For the reasons specified, Applicants respectfully disagree with the rejections.

Turning first to the Section 112 rejections, Applicants submit that the examiner has not established a *prima facie* case of failure to satisfy the written description requirement because no *reasons* are provided as to why one of ordinary skill in the art would not have recognized that Applicants were in possession of the claimed invention in view of the specification. *See* M.P.E.P. § 2163 (In setting forth a Section 112, first paragraph, rejection, the examiner *must* expressly present facts in support).

Notwithstanding this deficiency in the examiner’s case, Applicants submit that the specification reasonably conveys that they had possession of the invention as claimed.

To satisfy the written description requirement of Section 112, the disclosure need not *expressly* support the claimed subject matter; inherent or implicit support is equally satisfactory. Indeed, it is preferable that a patent disclosure not reiterate that which is already known in the art.

In this instance, while the term “non-self supporting” as used in the claims does not appear, *ipsis verbis*, in the specification, it is inherently present in the description of the portable enclosure as including both a frame and a covering of flexible material such as, for instance, traditional fabrics and plastic sheeting. See specification, p. 5. Covering materials such as the foregoing are well-known as being non-self-supporting *per se*, requiring a framework or other means in order to define an enclosure.

In light of this inherent disclosure of the claimed subject-matter, Applicants propose by this paper to amend the specification to expressly recite the non self-supporting nature of the covering comprehended by claims 1 and 6, and further submit that, in light of the foregoing, such amendment interjects no new matter into the specification.

With respect to the rejection of claims 6 and 7 over Husted, Applicants claim as their invention a portable enclosure comprising a collapsible frame characterized in that it tends spontaneously from a collapsed condition to an erected condition thereof, a flexible, non self-supporting covering substantially surrounding said frame to thereby define a walled enclosure, said covering removably attached to said frame and having an interior surface and an exterior surface bearing a first visible pattern.

In contrast, Husted discloses a collapsible hunting blind comprising a plurality of foldable sectional corner posts and spreader struts, such that the hunting blind can be erected only through a series of time-consuming assembly steps, as exhaustively explained in that patent:

“The steps to form the opened-up blind of FIG. 1 are quite simple and a preferred way is the following:

- A. Unroll the covering fabric from the frame bundle
- B. Spread out the floor panel on the ground or ice and anchor the feet as by placing stones on them

- C. Unfold all four of the corner posts and both spreader struts to their full lengths
- D. Step inside through the door flap and insert the lower pin **26** of each corner post in a hole **41** at the corners
- E. Install the two spreader struts, diagonally across the top corners, engaging the end notches **35** with the pins **26** at the tops of the posts
- F. Press the centers of the struts upwardly to bow them and create a crown in the roof panel, for drainage purposes.” Col. 5, lines 50-65.

Such is plainly *not* anticipatory of a portable enclosure as instantly claimed.

Turning now to the rejection of claim 1, it is the examiner’s position that Rush ‘605 teaches all aspects of Applicants’ invention but for a support element (which language is now replaced by recitation of the more expansive “frame”). As to this deficiency, the examiner contends that the Jepson format of claim 1 constitutes an admission that the missing structure is prior art, and that, on this basis, one of ordinary skill in the art would have considered it obvious to have provided a sheet of camouflage material such as disclosed in Rush over a portable enclosure such as recited in the preamble of claim 1. Applicants strenuously disagree, at least because the examiner has failed to establish a *prima facie* case of obviousness.

A *prima facie* case of obviousness *requires, inter alia*, some motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” See MPEP § 2143; *see also In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1998); and *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). Without motivation, it is irrelevant that the references *may* separately teach each and every element of the claimed invention. See *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” MPEP

§ 2143.01 (citing In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990)(*emphasis original*)). Nor is it enough to provide conclusory statements respecting a supposed motivation to combine. “The factual inquiry to combine references must be thorough and searching.” In re Sang Su Lee, 61 USPQ2d 1430 (Fed. Cir. 2001)(quoting McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001 (Fed. Cir. 2001)). “Particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components in the manner claimed.” *Id.* (quoting Brown & Williamson Tobacco Corp. v. Phillip Morris Inc., 56 USPQ2d 1456 (Fed. Cir. 2000)(*emphasis added*)).

In this instance, there is no motivation identified, in the prior art or elsewhere, which would have led one of ordinary skill to combine the camouflage sheet of Rush with a portable enclosure having a frame. In fact, Rush makes no explicit suggestion of any utility of the camouflage sheet thereof with any portable structure, whether having a frame or not.

In addition to motivation, a *prima facie* case of obviousness requires that the prior art teach or suggest all limitations of the claimed invention. Even accepting, *arguendo*, that the examiner has evidenced the requisite motivation to combine (which point Applicants are unwilling to concede), it remains the case that the examiner has not set forth a *prima facie* case of obviousness because the cited art fails to teach a separate cover which has a shape closely conforming to the shape of the enclosure. On the contrary, Rush teaches a rectangular camouflage sheet which is simply draped over a fixed structure, such as a military target. Such is evidenced in **FIG. 1** of Rush, which clearly depicts the rectangular camouflage sheet as having significantly greater dimensions than the underlying structure.

Plainly, the camouflage sheet of Rush is not characterized by a shape closely

conforming to the shape of the underlying structure.

In light of the foregoing, Applicants submit that the rejections of claims 2, 3 and 5 are rendered moot. This fact notwithstanding, Applicants further contest those “facts” of which the examiner takes Official Notice, and demand evidence thereof. *See* M.P.E.P. § 2143.03.

In view of the above, Applicants respectfully submit that the rejections as to the dependent claims 2, 3, 5 and 7 are rendered moot. Nevertheless, Applicants note that the art of record, taken alone or in any permissible combination, fails to either anticipate or render obvious the invention of these claims. Should the examiner maintain the rejections to the claims, Applicants reserve the right to place the claims in allowable form, argue the patentability thereof, and/or appeal such rejection.

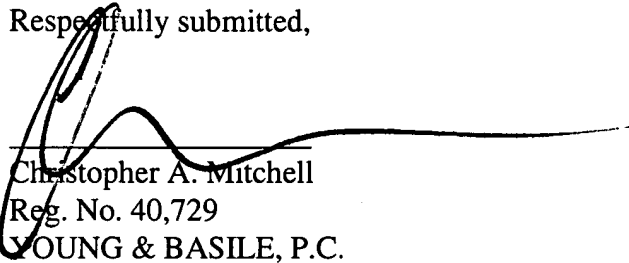
Respecting newly submitted claims 9-11, Applicants note that the prior art of record, taken alone or in any permissible combination, fails to teach or render obvious an apparatus comprising a portable enclosure having a frame and an enclosure exterior surface bearing a first camouflage pattern, and a flexible covering removably disposable over said enclosure exterior surface, said covering bearing a second camouflage pattern on a first covering surface, said covering having a second covering surface opposing said first covering surface, and said covering adapted to surround and cover substantially all of said enclosure exterior surface. Nevertheless, and in anticipation of the possible application of a rejection similar to that instantly made against claim 3, Applicants reassert, in the first instance, their demand for evidence supporting those “facts” of which the examiner takes Official Notice. *See* M.P.E.P. § 2143.03. But even accepting, *arguendo*, that such evidence exists, Applicants note that Rush fails to motivate the provision of the camouflage covering thereof over an already camouflaged structure. On

the contrary, Rush is quite explicitly directed to the provision of camouflage for otherwise conspicuous structures.

IV. Conclusion

In view of the foregoing, Applicants submit that the claims are in condition for immediate allowance. Of course, the examiner is invited to contact Applicants' undersigned counsel at (734) 662-0270 if he should have any questions respecting this paper, or if a telephonic interview might otherwise expedite the prosecution of this case.

Respectfully submitted,



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